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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,599	01/26/2001	Eric Neil Miller	0370-1-1	6893
25207	7590	08/01/2005	EXAMINER	
POWELL GOLDSTEIN LLP ONE ATLANTIC CENTER FOURTEENTH FLOOR 1201 WEST PEACHTREE STREET NW ATLANTA, GA 30309-3488			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/770,599

**Applicant(s)**

MILLER ET AL.

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on 4/29/05 is acknowledged. Applicant has canceled Group II, claims 15-17.

### ***Claim Rejections - 35 USC § 112***

2. Claims 2-8, 1, 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, it's not clear where steps (c) to (i) are carried out such as on the 1<sup>st</sup> website or 2<sup>nd</sup> website. Similarly, it's not clear whether the modules of (b) – (g) are related with the 1<sup>st</sup> website or 2<sup>nd</sup> website. It appears this deals with the 2<sup>nd</sup> website and not the charitable organization website or 1<sup>st</sup> website.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 2-8 (method), 1, 9-14 (apparatus) are rejected under 35 U.S.C. 103(a)** as being unpatentable over (Ref. 1) Article "OpenSite Technologies, ... E-business", October 13, 1998 (hereinafter as "**OpenSite Article**") in view (Ref. 2) **BEZOS et al** (US Patent 6,029,141) and (Ref. 3) **HOPKINS** (Article "Charity Auctions and Tax Law", Nov. 1994).

**As for independent method claim 2**, OpenSite Article fairly teaches a method for charitable donation management and reporting, comprising the steps of:

a) receiving at a 1<sup>st</sup> Internet website an indication from a donor to make a donation to the charitable organization, the 1<sup>st</sup> website being a website of a charitable organization;

c) displaying at least one asset (items/merchandises) available for purchase responsive to the donor's indication of interest to make the donation to the charitable organization;

e) receiving an indication from the donor to purchase the asset;

f) displaying selective delivery information responsive to the purchase of the asset (part of filling orders, invoices);

g) displaying selective payment information responsive to the purchase of the asset (part of filling orders, invoices);

h) displaying selective confirmation information responsive to the purchase of the asset part of filling orders, invoices); and

i) collecting transactional data concerning the donor, the donation made by the donor, and the purchase of the asset by the donor (or tracking customer) {see pages 1-2}. OpenSite Article fairly teaches the claimed invention except for step (b), and (d).

In a similar environment dealing with charity auctions and tax law, HOPKINS fairly teaches a donation level in concert with the asset to the donor, a) deductible payment to a charity for those that exceed the fair market value of anything that the donor may receive in return, and b) no charitable deduction payment for those that roughly equal to the fair market value of the item {see pages 3-4}. It would have been obvious to a skilled artisan, i.e. fundraising manager/marketer, at the time the invention was made to modify the teaching of OpenSite Article by including the donation level in concert with the purchase of the item to indicate level of charitable deduction. Note that on page 6, the last 3 paragraphs, show that "every transaction at a charitable auction" is, in whole or substantial part, a "purchase", thus engaging in "sales".

In a similar environment dealing with transaction of good/service between a customer and a business entity on the Internet/website, BEZOS et al teaches the hyperlink of a 1<sup>st</sup> website entity (function as a referral) to a 2<sup>nd</sup> website entity (function

Art Unit: 3629

as a merchant) to allow potential customers to make complete business transaction (sales) at the 2<sup>nd</sup> website entity for enhancing business efficiency since the 1<sup>st</sup> website lacks the resources needed to generate efficient marketing and profit, i.e. insufficient provision of business information about product to the customer and lack of usage of customer historical data for further transaction {see col. 1, lines 25-30, 50-67, col. 3, lines 10-40, col. 6, lines 1-45, col. 7, lines 5-25. Note on col. 6, lines 41-47, BEZOS et al discloses that the 2<sup>nd</sup> website would handle the tasks of processing online orders, shipping products, collecting payment, and providing customer service, and the 1<sup>st</sup> website need not be concerned with these tasks. It would have been obvious to a skilled artisan to modify the teachings of OpenSite Article /HOPKINS by including step (b) as taught by BEZOS et al to enhance the obtaining additional business and profits would have been obvious to a skilled artisan since the 1<sup>st</sup> website lacks the resources to carry out effective marketing. Note that on col. 8, BEZOS et al discloses that sales of product reads over sales of service. Therefore, offering any services that results in a financial transaction, i.e. donation of money, would have been obvious to a skilled artisan.

As for dep. claims 3-6 (part of 2) which deals with well known data exchange communication parameters, i.e. providing transactional between websites in the form of data/e-mail/report, these are fairly taught by BEZOS et al on col. 16, lines 10-25, Appendix B on col. 18, especially lines 25-30, or OpenSite Article page 2.

As for dep. claims 7-8 (part of 2) which deals with well known data exchange communication parameters, i.e. updating a listing of items/assets and items/assets

Art Unit: 3629

features, these are fairly taught by BEZOS et al on Appendix B, col. 18, lines 25-65, Figs. 10a, 10b, OpenSite Article page 2, HOPKINS pages 5-7.

**As for the independent system claim 1**, which is the apparatus/system to carry out the method of claim 2 above, it's rejected over server/software/modules to carry out the method of claim 2 as indicated above, see Figs. 1, 2, and 5.

As for dep. claims 9-14 (part of 1), which have the same limitations as in dep. claims 3-8 (part of 2) above, they are rejected for the same reasons set forth in dep. claims 3-8 as indicated above. See also Figs. 1, 2, and 5.

No claims are allowed.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Article "Publishers Clearing House and Linkshare Partner", Nov. 10, 1998, is cited to show the hyperlink between websites teachings similarly to the claimed invention. It's cited here for applicant's awareness of potential use in the next office action if needed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Art Unit: 3629

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtm  
July 24, 2005

  
DEAN T. NGUYEN  
PRIMARY EXAMINER